



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/527,257	03/09/2005	Jun Wu	186353/US	5292
25763 7590 05/08/2007 DORSEY & WHITNEY LLP INTELLECTUAL PROPERTY DEPARTMENT SUITE 1500 50 SOUTH SIXTH STREET MINNEAPOLIS, MN 55402-1498			EXAMINER BRISTOL, LYNN ANNE	
			ART UNIT 1643	PAPER NUMBER
			MAIL DATE 05/08/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/527,257

Applicant(s)

WU ET AL.

Examiner

Lynn Bristol

Art Unit

1643

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 March 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 9-13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) 1,3-7,14 and 15 is/are allowed.
- 6) ☒ Claim(s) 8 is/are rejected.
- 7) ☒ Claim(s) 2 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/9/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-15 are all the pending claims for this application.
2. The amendment to the specification to cross-reference the priority document in the Preliminary Amendment of 3/9/07 has been entered.
3. Claim 3 was amended and new Claims 14 and 15 were added in the Reply of 3/14/07. New claims 14 and 15 have been entered.

Change in Power of Attorney

4. The Examiner contacted Applicant's representative, Sean Solber, on May 4, 2007 to discuss the condition of the instant claims, and was informed by Applicant's docketing clerk, Chris Stefan, that the application had been transferred to another law firm since the Reply of 3/9/07. No revocation of POA or change in POA appears to have been filed. The Examiner contacted Applicant's representative of record, Min Xu to suggest contacting the new representative regarding the POA. Absent a timely response from Ms. Xu, the Examiner has issued the following Office Action.

Election/Restrictions

5. Applicant's election with traverse of Group II (Claims 3-8) with respect to Group I (Claims 1 and 2) in the reply filed on 3/14/07 is acknowledged. The traversal is on the ground(s) that because the RL5 protein of SEQ ID NO:2 is novel, the nucleotide sequence of nucleotides 1-639 in SEQ ID NO:1 and the amino acid sequence of SEQ ID NO:2 should be treated as a corresponding special technical feature (p. 5 of the

Art Unit: 1643

Reply of 3/14/07). Applicants allege that in some previously issued U.S. patents the new polypeptide and corresponding encoding nucleotide sequence have been treated as a corresponding technical feature. No patents are specifically referred to and none of the alleged attached pages from those patents were included with the Reply.

Applicants allegations are found persuasive and Claims 1, 2 14 and 15 (Group I) have been joined with claims 3-8.

6. Claims 9-13 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected inventive groups, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 3/14/07.

7. Claims 1-8, 14 and 15 are all the pending claims for this application.

Information Disclosure Statement

8. The international patent reference and non-patent literature references cited in the IDS of 3/9/05 have been considered and entered.

Specification

9. The disclosure is objected to because of the following informalities: the legends for Figures 2, 3 and 7 do not describe the figures in sufficient detail for the following reasons

Art Unit: 1643

a) Figure 2A and 2B disclose protein and nucleic acid sequences which are not identified in the figure or figure legend by sequence identifier. Further, the legend does not distinguish 2A from 2B;

b) The legend for Figure 3A and 3B does not describe what sort of analysis is being made on the membrane region for the proteins.

c) The legend of Figure 7 does not describe the expression spectrum for RL5 in tumor samples as being for mRNA.

Appropriate correction is required.

Claim Objections

10. Claim 2 is objected to because of the following informalities: Claim 2 recites what appears to be typographical error for the phrase "is consisting of" and which should instead recite "consists of". Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Art Unit: 1643

a) Claim 8 recites the limitation "the expression conditions" in element a). There is insufficient antecedent basis for this limitation in the claim.

b) Claim 8 recites the limitation "the culture" in element b). There is insufficient antecedent basis for this limitation in the claim.

Conclusion

12. Claims 1, 3-7, 14 and 15 are in condition for allowance. Claim 2 is objected to.

13. A sequence search of SEQ ID NO:2 and amino acid residues 29-213 of SEQ ID NO:2; and SEQ ID NO:1 and nucleotide residues 1-639 and 85-639 of SEQ ID NO:1 was performed in commercial protein and nucleotide sequence databases, respectively. Three post-filing date references were identified which disclose the sequences of SEQ ID NO: 1 and 2 as shown in the attached sequence alignments:

Strausberg et al. (PNAS 99:16899-16903 (December 2002)), was found to disclose a 213 amino acid residue protein having 99.5% identity with SEQ ID NO:2, and a fragment having 100% sequence identity with amino acid residues 29-213 of SEQ ID NO:2. Nucleotide residues 1-639 and 85-639 of SEQ ID NO:1 also aligned with corresponding sequences in Strasberg.

Bacon et al. (J. Immunol. 173:1078-1084 (2004) was found to disclose a nucleotide sequence having 100% identity with residues 1-639 and 85-639 of SEQ ID NO:1, and the nucleotide sequence encoding amino acid residues corresponding to SEQ ID NO:2 and residues 29-213 of SEQ ID NO:2.

Harkin et al. (US2006134663; filed 11/3/04) was found to disclose a nucleotide sequence having 100% identity with residues 1-639 and 85-639 of SEQ ID NO:1, and the nucleotide sequence encoding amino acid residues corresponding to SEQ ID NO:2 and residues 29-213 of SEQ ID NO:2.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lynn Bristol whose telephone number is 571-272-6883. The examiner can normally be reached on 8:00-4:00, Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Helms can be reached on 571-272-0832. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

LAB



LARRY R. HELMS, PH.D.
SUPERVISORY PATENT EXAMINER